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10/510,684

10/08/2004

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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

05/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                     |  |
|------------------------------|--------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/510,684 | <b>Applicant(s)</b><br>ENDOU ET AL. |  |
|                              | <b>Examiner</b><br>Kuo-Liang Peng    | <b>Art Unit</b><br>1796             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2/11/08 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-14 and 19-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7-14, 19-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The Applicants' amendment filed February 11, 2008 is acknowledged. Claims 2, 6 and 15-18 are deleted. Claims 4, 10, 25 and 31 are amended. Now, Claims 1, 3-5, 7-14 and 19-35 are pending.

2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 090107) is/are removed.

3. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

#### ***Claim Rejections - 35 USC § 103***

4. Rejection of Claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 under 35 USC 103(a) as being unpatentable over Haynes (EP 067 468, US 4 379 891) in view of Ishikawa (US 6 191 247) and rejection of Claims 23 and 32 under 35 U.S.C. 103(a) as being unpatentable over Haynes in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne (US 6 403 693) are maintained because the rejection is adequately set

forth in paragraphs 7 and 8 of Paper No. 090107. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, (B)(A)(1)), Examiner disagrees. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) Therefore, arguing the motivation of the employment of the condensation catalyst in the prior art is different than that of the claimed invention does not appear persuasive.

For Applicants' argument (Remarks, (B)(A)(2)), Examiner disagrees. Applicants' assertion is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

For Applicants' argument (Remarks, (B)(A)(3)), Examiner disagrees. Applicants' assertion is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993) Furthermore,

since the prior art's functionalized polymer (P-F as denoted in Applicants' argument) is essentially the same as the precursor of the alleged condensed polymer (condensed P-F' as denoted in Applicants' argument), the former obviously can form the alleged condensed P-F', especially, in the presence of the claimed condensation catalyst.

For Applicants' argument (Remarks, (B)(B)), Examiner disagrees because of the following reasons: First, Examiner is not able to find the basis for the alleged free of formation of a polysiloxane network at the surface of the filler and/or within the elastomer in the present invention. Even if the basis did exist, Applicants' assertion is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993) Second, notably, as pointed out by Applicants, in Materne's disclosure, the formation of a polysiloxane network at the surface of the filler and/or within the elastomer is merely a **hypothesis**. Even if it were true, as the prior art's functionalized polymer (P-F as denoted in Applicants' argument) is essentially the same as the precursor of the alleged condensed polymer (condensed P-F' as denoted in Applicants' argument), the final products should be **the same** (i.e., whether the presence or absence of the formation of a polysiloxane network at the surface of the filler

and/or within the elastomer), especially, in the presence of the claimed condensation catalyst.

5. Rejection of Claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 under 35 USC 103(a) as being unpatentable over Ozawa (WO 01/34658, US 6 992 147), **optionally** in view of Ishikawa (US 6 191 247) and rejection of Claims 23 and 32 under 35 U.S.C. 103(a) as being unpatentable over Ozawa, optionally in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne are maintained because the rejection is adequately set forth in paragraphs 9 and 10 of Paper No. 090107. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, (B)(C)), Examiner disagrees because of the following reasons: First, the interpretation of claims should be as reasonably broad as possible. Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof. Second, the alleged step of incorporating the condensation accelerator is not claimed. Although the claims are interpreted in light of the specification, limitations from the

specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993) Third, the claimed invention does not exclude the presence of a filler such as silica during the process of the modified polymer preparation.

For Applicants' argument (Remarks, (B)(D)), Examiner cannot find the basis of Applicants' assertion, i.e., Ozawa's modified polymer is liquid. On the contrary, Ozawa teaches that the modified polymer can be a **rubber** (i.e., not a liquid) component. (col. 3, lines 4-22)

6. Rejection of Claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeishi908 (US 6 228 908) in view of Ishikawa and rejection of Claims 23 and 32 under 35 U.S.C. 103(a) as being unpatentable over Takeishi in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne are maintained because the rejection is adequately set forth in paragraphs 11 and 12 of Paper No. 090107. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, (B)(E)), Examiner disagrees because of the following reasons: First, the interpretation of claims should be as reasonably broad as possible. Applicants are advised that Ishikawa' silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof. Second, the alleged step of incorporating the condensation accelerator is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993) Third, the claimed invention does not exclude the presence of a filler such as silica during the process of the modified polymer preparation.

For Applicants' argument (Remarks, (B)(F)), Takeishi908 is silent on the use of a condensation catalyst in liquid polymerization system. However, the combination set forth in the rejection is that Ishikawa and Materne's condensation catalyst is added to the modified polymer in Takeshi908, rather than the Takeshi908's liquid polymerization system. As such, arguing no technical relevance by combining Takeichi908 and Ishikawa or Materne is lack of merit.



7. Rejection Claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan (US 6 573 412) in view of Ishikawa and rejection of Claims 23 and 32 under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne are maintained because the rejection is adequately set forth in paragraphs 13 and 14 of Paper No. 090107. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, (B)(G) and (B)(H)), Examiner disagrees because of the following reasons: First, the interpretation of claims should be as reasonably broad as possible. Applicants are advised that Ishikawa's silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof. Second, the alleged step of incorporating the condensation accelerator is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

8. Claims 1, 3-5, 7-14, 19-22, 24-31 and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 6 369 167) in view of Ishikawa and rejection of Claims 23 and 32 under 35 U.S.C. 103(a) as being unpatentable over Marita in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne are maintained because the rejection is adequately set forth in paragraphs 15 and 16 of Paper No. 090107. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, (B)(I) and (B)(J)), Examiner disagrees because of the following reasons: First, the interpretation of claims should be as reasonably broad as possible. Applicants are advised that Ishikawa's silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof. Second, the alleged step of incorporating the condensation accelerator is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

9. Claims 1, 3-5, 7-14 and 19-21, 22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeichi295 (US 6 008 295) in view of Ishikawa and rejection of Claims 23 and 32 under 35 U.S.C. 103(a) as being unpatentable over Takeichi295 in view of Ishikawa as applied to claims 1, 3-5, 7-14, 19-21, 24-28, 30-31 and 33-35 above, and further in view of Materne are maintained because the rejection is adequately set forth in paragraphs 17 and 18 of Paper No. 090107. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, (B)(K) and (B)(L)), Examiner disagrees because of the following reasons: First, the interpretation of claims should be as reasonably broad as possible. Applicants are advised that Ishikawa's silanol condensation catalyst is blended in a dry mixing stage for the rubber composition. As such, it is indeed added to the reaction system **after completion** thereof. Second, the alleged step of incorporating the condensation accelerator is not claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Guens*, 988 F. 2d 1811, 26 USPQ 2d 1057 (Fed. Cir. 1993)

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval

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(PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
May 23, 2008

/Kuo-Liang Peng/  
Primary Examiner, Art Unit 1796